

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Lynn A. Casey et al.	Atty. Docket No.: 005222.00135
Serial No.: 09/970,789	Group Art Unit: 3629
Filed: October 05, 2001	Examiner: Plucinski, Jamisue A.
For: Inspecting And Releasing Goods At A Land, Air, Or Sea Border	Confirmation No.: 1077

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully apply and/or petition for reconsideration under 35 U.S.C. § 154(b) and 37 C.F.R. §1.705(b) of the patent term adjustment indicated on the Notice of Allowance (“Notice”) for the above-identified application.

Statement of Pertinent Facts

1. The application was filed on October 5, 2001.
2. Fourteen (14) months after filing the application was December 5, 2002.
3. The date three years after filing was October 5, 2004.
4. The first office action was mailed March 27, 2006.
5. The response to the first office action was entered on November 3, 2006.
6. The second office action was mailed October 17, 2007.
7. The date of the first request for continued examination was February 15, 2008.

8. The application will issue as a patent after September 17, 2009.
9. The above-captioned application is not subject to a terminal disclaimer.
10. The delay by Applicants totals 129 days.
11. Applicants are due a total patent term adjustment of at least 1769 days (see remarks below for detailed explanation).

Remarks

The Notice indicates a term adjustment of 1159 days. However, Applicants respectfully submit that such a determination is not correct under 37 C.F.R. 1.702-1.705. In this case, a patent term adjustment is available under both 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B). With respect to these Sections, a patent term adjustment is calculated by the delay under subsection (b)(1)(A), plus the delay under subsection (b)(1)(B), minus any overlap occurring on the same calendar day between subsection (b)(1)(A) and subsection (b)(1)(B). *Wyeth v. Dudas*, No. 07-1492, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). Therefore, under 37 C.F.R. 1.702-1.705, the proper term adjustment in this case should be calculated as the sum of:

(1) the number of days after 14 months of initial filing that it took for the first office action to be mailed, and the number of days beginning after 4 months of the filing of a reply in compliance with 37 C.F.R. 113(c) and ending on the date of mailing of an action under 35 U.S.C. 132 (*see* 35 U.S.C. § 154(b)(1)(A), hereafter “A Delay”) PLUS;

(2) the number of days of pendency of the application beyond three years, not including the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. § 132(b) was filed and ending on the date the patent was issued (*see* 35 U.S.C. § 154(b)(1)(B); 37 C.F.R. 1.703, hereafter “B Delay”); LESS

- (3) any calendar days where the periods of A Delay and B Delay overlap; and
- (4) applicants' delay.

Applicants calculate the A Delay under 37 C.F.R. 1.703(a) as 1208 days. Applicants calculate the B Delay under 37 C.F.R. 1.703(b) as at least 1228 days. (i.e., from October 5, 2004 to the date the first request for continued examination was entered, February 15, 2008.) Applicants would also like to note the A Delay can increase under 37 C.F.R. 1-703(a)(6).

The overlap between A Delay and B Delay is the number of calendar days between the three year date, October 5, 2008, and the mailing of the first office action, March 27, 2006. Applicants calculate the overlap of A Delay and B Delay as 538 days. Applicants' delays totals 129 days. (i.e., from the deadline for response to the first office action, June 27, 2006, to the date the response was entered, November 3, 2006.) When calculating the patent term adjustment, these days are deducted from the sum of the A Delay and B Delay.

In total, Applicants believe they are entitled to a patent term adjustment of at least 1208 days in A Delays, plus at least 1228 days in B Delays, less 538 days overlap of A Delay and B Delay and 129 days of Applicants' delay. Accordingly, Applicants are entitled to a patent term adjustment of at least 1769 days.

Thus, the Applicants hereby request that the PTA be corrected from 1208 days to a total of at least 1769 days.

To any extent the USPTO is taking a position adverse to Wyeth in view of the pending appeal of the Wyeth decision, Applicant respectfully requests that a decision on this petition be held in abeyance until such time as Wyeth has been finally decided.

A fee of \$200 is believed to be due for this petition. The Office is authorized to charge any additional fee or reimburse any overpayment for this paper to our Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: December 15, 2009

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